

Notice of Allowability

Application No.

10/618,947

Applicant(s)

GROSS ET AL.

Examiner

Art Unit

Zachary C. Tucker

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 20 June 2005.
2. ☒ The allowed claim(s) is/are 1.
3. ☐ The drawings filed on _____ are accepted by the Examiner. *(No drawings)*
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

JAMES O. WILSON**SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600**

Response to Amendment

The single claim has been amended as requested in the correspondence from applicants filed 20 June 2005 (hereinafter "the present amendment"), which is in reply to the Office action mailed 22 March 2005 (hereinafter "previous Office action").

Status of Double Patenting Rejection

In the previous Office action, the single claim was rejected under the judicially-created doctrine of obviousness-type double patenting over claim 21 of U.S. Patent 6,617,327. The double patenting rejection is hereby withdrawn in view of there having been filed a petition for Certificate of Correction, granted, for U.S. Patent 6,617,327. Claim 21 of the patent now does not recite conditions recited in the instant claim.

Status of Claim Rejections - 35 USC § 112

In the previous Office action, the single claim was rejected under 35 U.S.C. 112, first paragraph, for failing to comply with the enablement requirement.

The rejection is hereby withdrawn in view of the present amendment, which deletes "eating disorders," "cocaine addiction" and "sexual dysfunction" from the claim. The generic terms "eating disorders" and "sexual dysfunctions" have been replaced with "anorexia nervosa, bulimia nervosa" and "premature ejaculation," respectively, which are more specific and narrower terminologies.

In the statement of the enablement rejection in the previous Office action, it was put forth that anorexia nervosa is not treatable with any drug, as taught by the cited Crow and Mitchell reference (page 5 of the previous Office action). Applicants' counsel has presented evidence that in fact anorexia nervosa has been treated with drugs

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having the activity possessed by the compounds of formula I (Selective Serotonin Reuptake Inhibition) and therefore, there is no reason to believe that one of ordinary skill in the art could not also do so with a compound according to formula I, without an undue amount of experimentation. Three references have been submitted with the present amendment that show successful treatment of anorexia nervosa with SSRI drugs. Therefore, the contention that anorexia nervosa is not treatable with any drug is recanted.

The three references submitted with the present amendment were included as an appendix to the remarks; the examiner has cited them formally on a PTO-892 form so that the references will appear on the face of a printed patent issuing from the instant application, as they were relied upon in withdrawing a claim rejection.

Allowable Subject Matter

The single claim is allowed.

The following is an examiner's statement of reasons for allowance:

Conditions recited in the claim are deemed to be treatable with an SSRI drug, and evidence specific to each is on the record in the instant application. No prior art anticipating or rendering obvious the compound according to formula I, which is the therapeutic agent employed in the claimed method is known. Compounds according to formula I, and some methods of treatment therewith were patented in the parent application, now U.S. Patent 6,617,327.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably

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accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

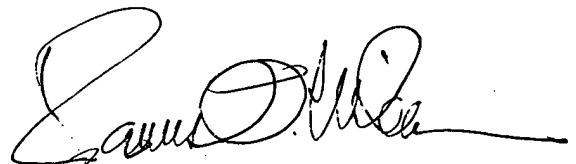
All Post-Allowance Correspondence concerning this application must be mailed to:

Mail Stop Issue Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Or you can fax them to the Office of Patent Publications at 703-872-9306, in order to expedite the handling of such correspondence as amendments under 37 CFR 1.312; information disclosure statements, and formal drawings. Sending Post-Allowance papers to Technology Center 1600 will only cause delays in matching papers with the case.

For information concerning status of correspondence sent after receipt of the Notice of Allowance, please contact the Correspondence Branch at (703) 305-8027. The Notice of Allowance also has an insert containing contact information on other items, including Issue Fees, receipt of formal drawings and the status of the application.

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